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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,681	02/20/2007	Sergei Anatolevich Lukyanov	U 015745-9	6233
24353 7590 04/13/2010 BOZICEVIC, FIELD & FRANCIS LLP 1900 UNIVERSITY AVENUE SUITE 200 EAST PALO ALTO, CA 94303				
EXAMINER				
SHEN, WU CHENG WINSTON				
ART UNIT		PAPER NUMBER		
1632				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# **Advisory Action** **Before the Filing of an Appeal Brief**

<b>Application No.</b> 10/532,681	<b>Applicant(s)</b> LUKYANOV ET AL.
<b>Examiner</b> WU-CHENG Winston SHEN	<b>Art Unit</b> 1632

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 07 April 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## **NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

## **AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-5, 8, 13, 17 and 27-33.  
Claim(s) withdrawn from consideration: 9-11 and 14-16.

## **AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

## **REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

## Continuation of 3. NOTE:

The proposed amendments to claim 1 "wherein said protein at least 90% identity with fully length SEQ ID No: 10" narrow the scope of the protein, and the proposed amendments to claim 13 "wherein said nucleic acid comprises a sequence that is identical to a nucleotide sequence of at least 300 contiguous nucleotides in length of SEQ ID No: 9" change the scope of the nucleic acid. The proposed alteration in scope of protein and nucleic acid sequences encompassed by the proposed amended claims raises new issues that would require further consideration and/or search for prior art in terms of (i) 112 first, written description and enablement rejection, (ii) potential rejection 103 rejection, and (iii) 112 second rejection, whether claim 13 is further limiting claim 1.

## Continuation of 11. does NOT place the application in condition for allowance because:

- (i) Applicant's arguments have failed to overcome the rejection of claims 1, 5-8, 13, 17, and 27-33 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention BECAUSE Applicant's arguments rely on the proposed claim amendments, which have not been entered. The rejection is maintained of the record.
- (ii) Applicant's arguments have failed to overcome the written description rejection of claims 1, 5-8, 13, 17, 27-33 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention BECAUSE Applicant's arguments rely on the proposed claim amendments, which have not been entered. The rejection is maintained of the record.
- (iii) Applicant's arguments have failed to overcome the scope of enablement rejection of claims 1, 5-8, 13, 17, 27-33 under 35 U.S.C. 112, first paragraph, as the specification, while being enabling for an isolated nucleic acid molecule comprising of SEQ ID No. 9 that encodes a fluorescent protein consisting of SEQ ID No. 10, and a vector/cell/kit comprising SEQ ID No. 9 that encodes a fluorescent protein consisting of SEQ ID No. 10, does not reasonably provide enablement for (1) any isolated nucleic acid molecule encodes a fluorescent protein other than SEQ ID No. 9 that encodes a fluorescent protein consisting of SEQ ID No. 10, or (2) any vector/cell/kit comprising any isolated nucleic acid molecule encodes a fluorescent protein other than SEQ ID No. 9 that encodes a fluorescent protein consisting of SEQ ID No. 10 BECAUSE Applicant's arguments rely on the proposed claim amendments, which have not been entered. The rejection is maintained of the record.
- (iv) Applicant's arguments have failed to overcome the rejection of claims 1, 5-8, 13, 17, 27-33 under 35 U.S.C. 102(e) as being anticipated by Baubet et al. (Baubet et al., US 2008/0213879, publication date 09/04/2008, Division of US 6,936,475, which is a continuation of PCT/EP01/07057, WO 2001/092300, filed on 06/01/2001) BECAUSE Applicant's arguments rely on the proposed claim amendments, which have not been entered. The rejection is maintained of the record.
- (v) Applicant's arguments have failed to overcome the rejection of claims 1, 5-8, 13, 17, 27-33 under 35 U.S.C. 102(b) as being anticipated by Baubet et al. (PCT/EP01/07057, WO 2001/092300, filed on 06/01/2001) BECAUSE Applicant's arguments rely on the proposed claim amendments, which have not been entered. The rejection is maintained of the record.

/Wu-Cheng Winston Shen/  
Primary Examiner, Art Unit 1632